

REMARKS

Claims 1-5, 7-10, 13-15, and 21-27 are pending, in which claim 6 is canceled without prejudice or disclaimer, claims 13-15 are withdrawn from consideration, claims 1, 2, 7, 21, 26, and 27 are currently amended, and claim 28 is newly presented. No new matter is introduced.

The Office Action mailed September 7, 2011 rejected claims 1-10 and 21-26 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, rejected claim 6 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement, rejected claims 1-10 and 21-23 under 35 U.S.C. § 102 as being anticipated by *Tatsuta et al.* (U.S. Pub. 2002/0125318) (hereinafter, “*Tatsuta*”), rejected claim 24 under 35 U.S.C. § 103 as being obvious based on *Tatsuta* as evidenced by Applicant’s Specification or by *Bloomfield* (U.S. Pub. 2002/0028704) (hereinafter, “*Bloomfield*”), rejected claim 25 under 35 U.S.C. § 103 as being obvious based on *Tatsuta* in view of *Dark Age of Camelot Shines* by Royce Brainard (website game review article, 6/30/2004 edition) (hereinafter, “*Dark Age*”), and rejected claims 26 and 27 under 35 U.S.C. § 103 as being obvious based on *Tatsuta* as supported by Applicant’s Specification, or in view of *Bloomfield*. The rejections are respectfully traversed.

First, Applicant acknowledges with appreciation the courtesy of a telephonic interview granted to Applicant’s representative on December 12, 2011 at which time the claimed invention was explained in light of Applicant’s disclosure, the outstanding issues were discussed, and arguments substantially as hereinafter developed were presented. No formal agreement was reached, pending the Examiner’s detailed reconsideration of the application upon formal submission of a response to the outstanding Office Action.

Claims 1-10 and 21-26 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement.

Applicant respectfully disagrees with the Examiner's contention that claims 1-10 and 21-26 fail to comply with the enablement requirement. Specifically, the Examiner alleges, on page 2 of the Office Action, that "with the at least one processor, cause the apparatus to perform at least the following, associate each one of a plurality of device configurations based, at least in part, on a presence of one or more hardware components with associated functional capabilities of a device, with a respective game configuration" of claims 1-10 and 21-26 fails to comply with the enablement requirement. In an attempt to support such assertions, the Examiner further argues that "Applicant's invention fails to disclose how a processor can determine what the real world capability of a device is and then associate it with a game configuration." Nonetheless, the Examiner is misguided.

As explained in the Response filed November 5, 2010, and also in the telephonic interview, the Federal Circuit has repeatedly held that "[a] patent is not a scientific treatise, but a document that presumes a readership skilled in the field of the invention." *Ajinomoto Co. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 1347 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 1019 (2001) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556 (Fed. Cir. 1983) (holding that "[p]atents, however, are written to enable those skilled in the art to practice the invention, not the public"), *cert. denied*, 469 U.S. 851 (1984)) (emphasis added). That is, the instant Specification satisfies the enablement requirement as long as one of ordinary skill would reasonably be enabled to practice the claimed invention with the recited associating step. In this case, it is clear that such requirement is met. For example, as illustrated on page 2 of the Office Action, even the Examiner understands how a similar association may be performed,

stating that “it will be interpreted that the capabilities of a device, are capabilities that was programmed, or information stored onto the device” (e.g., a processor may simply read such programmed or stored information in order to perform an association of device configurations with game configurations, *see* paragraph [0043] of the Published Application).

Moreover, the above-recited claimed features have been amended to recite “with the at least one processor, cause the apparatus to perform at least the following, associate each one of a plurality of device configurations with a respective game configuration according to a presence of one or more hardware components of a device, wherein the one or more hardware components have one or more functional hardware capabilities, and each game configuration differently specifies one or more parameters of a game.” Adequate support for the claimed features is located throughout the Specification, such as the data structure in original claim 1 as well as paragraphs [0031]-[0035] and [0043]-[0045] (e.g., “The set of game parameters associated with a physical device configuration may be referred to as a game configuration,” “The configuration of the device 10 may consequently be identified by the processor 12 reading the identifier from the memory 16,” “The Class of Device indicates the capabilities of a Bluetooth device and can be obtained using the Device Discovery procedure,” “If the electronic device 10 has a vibrating alert then the user gaming object may have a warning, lightning or earthquake skill,” etc.). Further, claim 6 has been canceled without prejudice or disclaimer, and, thus, the rejection with respect to claim 6 is now moot. Accordingly, withdrawal of the rejection is respectfully requested.

Claim 6 is rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement.

Applicant respectfully disagrees with the Examiner's assertion that claim 6 fails to comply with the written description requirement. Applicant kindly notes that the "fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed." MPEP § 2163 (emphasis added). In the present case, the instant Specification clearly demonstrates that Applicant was in possession of "wherein the apparatus is further caused to: update the device configurations," as of the filing date sought.

As acknowledged by the Examiner, on page 4 of the Office Action, "Applicant specification (paragraph 37 of Applicant's published specification), discloses that the game configuration associated with a particular device configuration is updated." In addition, paragraphs [0018] and [0019] provide a hard-portable electronic device 10 that may include at least a processor 12, a memory 16, and a cellular radio transceiver 24. Moreover, paragraph [0019] describes that the "processor 12 is connected in two-way communication with the memory 15 . . . and the radio cellular transceiver 24," and paragraph [0036] discloses that "the memory 16 stores a data structure 17, which associates each one of a plurality of device configurations with a particular respective set of game parameters." Further, paragraph [0037] provides that the "data structure 17 may be updated via messages received through the cellular radio transceiver 24" (e.g., the processor 12 communicates with the cellular radio transceiver 24, *see* paragraph [0019]), and that updating "the data structure enables the game configuration associated with a particular device configuration to be updated." Thus, there is no question that the instant Specification "conveys with reasonable clarity to those skilled in the art that, as of the

filing date sought, applicant was in possession of the invention as now claimed,” (emphasis added), as required by MPEP § 2163.

Regardless, claim 6 has been canceled without prejudice or disclaimer. As such, the rejection based on the written description requirement is now moot. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 1-10 and 21-23 are rejected under 35 U.S.C. § 102 as being anticipated by *Tatsuta*.

Applicants respectfully disagree with the Examiner’s interpretation, and conclusion, that the applied reference discloses all of the claimed features. In this case, there are substantial differences between the claimed features and those of the applied references. For example, independent claim 1 recites, *inter alia*, “associate each one of a plurality of device configurations with a respective game configuration according to a presence of one or more hardware components of a device, wherein the one or more hardware components have one or more functional hardware capabilities, and each game configuration differently specifies one or more parameters of a game.” (Emphasis added). Applicant submits, as presented below, that the applied reference does not disclose such features.

With respect to such features, the Examiner relies on paragraph [0165] of *Tatsuta*, the relevant portions of which are provided below (emphasis added):

If the recording medium 400, or the playing card, has an oblong rectangular profile, the graphic display region 431 is arranged in the upper half of the card or in an upper half area larger than a half of the entire surface area of the card, and a character image of an animal, a person or an imaginary monster may be printed there. **The kind, design or pattern of the character image printed in the graphic display area 431 may vary from card to card in order to represent the characteristic of the playing card. It may be an image of a character (a character of the**

protagonist, a character of the party or the adversary or any character whose image can be an object of collection) that appears on the game screen when the **game program stored in the program ROM 201 of the application program storing cartridge 200 is executed**. A number of such playing cards (e. g., 30 to 40 cards) may be collected into a set (which is referred to as a "starter kit"), each carrying, with arbitrary probability, an image of a funny or cute character that is an object of collection, and put up for sale with or without the code reading apparatus main body 100 and application program storing cartridge 200. A set of duplicates of a small number of different cards (which is referred to as "expansion pack") may also be put up for sale. When the code reading apparatus main body 100 and the application program storing cartridge 200 are provided separately, the starter kit may be sold with the application program storing cartridge 200.

As interpreted by the Examiner, on pages 5 and 15 of the Office Action, *Tatsuta's* recording medium 400, or its playing card, "has the functional capability of storing information and providing illustrated data and information data for amusement and entertainment purposes." Even if assuming, *arguendo*, that the Examiner's interpretation is correct, there is no mention anywhere in the *Tatsuta* reference that any associations of the device configurations with respective game configurations are according to a presence of the storage component of the recording medium 400, or its playing card. Thus, *Tatsuta* does not disclose "associate each one of a plurality of device configurations with a respective game configuration according to a presence of one or more hardware components of a device, wherein the one or more hardware components have one or more functional hardware capabilities, and each game configuration differently specifies one or more parameters of a game," as recited by independent claim 1 (emphasis added). Accordingly, withdrawal of the rejection is respectfully requested.

Claim 24 are rejected under 35 U.S.C. § 103 as being obvious based on *Tatsuta* as evidenced by Applicant's Specification or by *Bloomfield*.

With respect to the rejection of claim 24 under 35 U.S.C. § 103, the secondary reference of *Bloomfield* fails to overcome the deficiencies set forth above with respect to the rejection of independent claim 1. Therefore, claim 24 also is patentable for at least the reasons independent claim 1 is patentable, from which claim 24 depends, as well as for the additional features the dependent claim recites.

Claim 25 is rejected under 35 U.S.C. § 103 as being obvious based on *Tatsuta* in view of *Dark Age*.

With respect to the rejection of claim 25 under 35 U.S.C. § 103, the secondary reference of *Dark Age* fails to overcome the deficiencies set forth above with respect to the rejection of independent claim 1. Therefore, claim 25 also is patentable for at least the reasons independent claim 1 is patentable, from which claim 25 depends, as well as for the additional features the dependent claim recites.

Claims 26 and 27 are rejected under 35 U.S.C. § 103 as being obvious based on *Tatsuta* as supported by Applicant's Specification, or in view of *Bloomfield*.

With respect to the rejection of claims 26 and 27 under 35 U.S.C. § 103, the secondary reference of *Bloomfield* fails to overcome the deficiencies set forth above with respect to the rejection of independent claim 1. Therefore, claims 26 and 27 also are patentable for at least the reasons independent claim 1 is patentable, from which claims 26 and 27 depend, as well as for the additional features the dependent claims recite.

New claim 28.

Independent claim 28 similar recites the above-disclosed features of independent claim 1 in varying scope. Thus, independent claim 28 is patentable for at least the reasons set forth for independent claim 1.

As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, ability to combine references, assertions as to patentability of dependent claims) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such assertions in the future.

Therefore, the present application, as amended, overcomes the rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 519-9952 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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